

**REMARKS**

Claims 371-483 are pending in the application.

The Office rejected claims 371-483 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,070,150 to Remington et al. ("the Remington patent") in view of Electronic Funds Transfer Project, Final Report, Washington State, October 1994.

Applicant respectfully traverses this rejection. The Remington patent cannot render any of the present claims obvious, alone or in combination, at least because the Remington patent does not qualify as prior art to the present application.

Applicant submits herewith a Declaration under 37 C.F.R. § 1.131, executed by Mr. John Polk ("the Polk declaration"), the named inventor of the claimed subject matter; a Declaration under 37 C.F.R. § 1.131, executed by Mr. Richard ("Dick") Vesper ("the Vesper declaration"); and a Declaration under 37 C.F.R. § 1.131, executed by Mr. Lionel M. Lavenue ("the Lavenue declaration"). These declarations establish that conception of the present invention occurred prior to October 18, 1996, the filing date of the Remington patent. In addition, these declarations establish that reasonable diligence was exercised by the inventor and the attorneys preparing the application from a date prior to October 18, 1996 through September 30, 1997, the filing date of U.S. patent application No. 08/941,187, the great-grandparent of the present application. The present application is a continuation of U.S. Patent Application No. 09/413,862, filed October 7, 1999, which is a continuation of U.S. Patent Application No. 09/003,941, filed January 7, 1998 (now U.S. Patent No. 6,119,107), which is a divisional of U.S. Patent Application 08/941,187 ("the '187 application"), filed September 30, 1997, now U.S. Patent No. 5,946,669 ("the '669 patent").

Under 37 C.F.R. § 1.131(b), establishment of conception of the invention prior to the effective date of the reference coupled with diligence from prior to the reference's effective date to a subsequent actual or constructive reduction to practice overcomes a rejection based on that reference. For the reasons discussed below, the Polk declaration with its attached exhibits 1-68, the Vesper declaration, and the Lavenue declaration fulfill the requirements of 37 C.F.R. § 1.131, establishing invention prior to the effective date of the Remington patent, thereby removing the Remington patent as a reference and overcoming each of the rejections.

A. Conception

"Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it therefore is to be applied in practice. *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997).

Of the rejected claims, the present invention is set forth most broadly in independent claims 371, 375, 379, 383, 389, 395, 396, 400, 404, 405, 422, 440, 448, 456, and 470. According to the Polk declaration, the inventor prepared drawings depicting specific aspects of the invention prior to October 18, 1996. Polk Decl. ¶¶ 8-9. These drawings depict the subject matter of claims 371, 375, 379, 440, 448, 456, and 470. Polk Decl. ¶¶ 10-11. Further, the drawings depict the subject matter of claims 383, 389, 395, 396, 400, 404, 405, 422,. Polk Decl. ¶ 12. The drawings are attached as Exhibits 1 and 2 to the Polk declaration. Polk Decl. ¶ 8. Although the drawings in Exhibits 1 and 2 include no signatures of a corroborating witness, corroboration is not needed to antedate a reference with a Rule 131 declaration. "An inventor's testimony

alone as set forth in the declaration is sufficient to show conception and diligence.” *Ex parte Hook*, 102 USPQ 130, 131 (Bd. App. 1953); M.P.E.P. § 715.07.

Based on the disclosures in the drawings made by the inventor prior to October 18, 1996, one of ordinary skill could have reduced the invention to practice without extensive experimentation. Polk Decl. ¶ 14. Conception is complete when only the exercise of ordinary skill rather than extensive experimentation is required to reduce the invention to practice. *In re Jolley*, 308 F.3d 1317, 1324 (Fed. Cir. 2002); *In re Tansel*, 253 F.2d 241, 243 (C.C.P.A. 1958).

Accordingly, the Polk declaration establishes conception of the invention as set forth in independent claims 371, 375, 379, 383, 389, 395, 396, 400, 404, 405, 422, 440, 448, 456, and 470 before the effective date of the Remington patent.<sup>1</sup> In addition, the Polk declaration establishes conception of the invention as set forth in all the dependent claims.

## 2. Diligence

The Polk declaration also establishes reasonable diligence from a date just prior to October 18, 1996 until the filing date of the parent application, *i.e.*, a constructive reduction to practice. M.P.E.P. § 715.07(a). The Vesper declaration and the Lavenue declaration provide additional supporting detail.

As stated in the Polk declaration ¶¶ 15-48, Exhibits 3-68 are documents dating from October 15, 1996 through September 30, 1997, and include daily planner records,

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<sup>1</sup> The remaining rejected claims are dependent claims, depending from one of the above-cited independent claims, respectively, and adding to their respective independent claims one or more features which, when taken with the invention, were well within the skill of persons of ordinary skill in the art at the time of the conception of the respective independent claims. Polk Decl. ¶ 13.

written correspondence, and attorney billing records. These records, authenticated by the Polk declaration and the Lavenue declaration, establish the inventor's and the patent attorney's ongoing affirmative acts, following conception, toward constructively reducing the invention to practice by filing a U.S. patent application. These materials account for the entire period during which diligence is required, *i.e.*, a date prior to the Remington patent's effective date of October 18, 1996, through the date of constructive reduction to practice on September 30, 1997. *Hunter v. Beissbarth*, 230 U.S.P.Q. 305, 308 (Bd. App. 1986). These materials, moreover, depict affirmative acts or reasonable excuses for non-action. Reasonable excuses for non-action include illness, vacation, and responsibilities to other job demands, family or other duties. *Hybritech Inc. v. Abbott Labs.*, 4 U.S.P.Q. 2d 1001, 1006 (C.D. Cal. 1987), *aff'd* 849 F.2d 1446 (Fed. Cir. 1988); *Griffith v. Kanamaru*, 816 F.2d 624, 626-27 (Fed. Cir. 1987); *In re Jolley*, 308 F.3d at 1327; *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261 F.3d 1356, 1369 (Fed. Cir. 2001).

These documents establish that the inventor was diligent from just before October 18, 1996, until the constructive reduction to practice. In summary, on October 15, 1996, the inventor began developing plans for constructively reducing the invention to practice. See Polk Decl. ¶ 16. The inventor then prepared a written description, which was submitted to corporate counsel for consideration. See Polk Decl. ¶ 18; Vesper Decl. ¶ 6. Corporate counsel then sent the written description to the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. "(FHFGD)" See Polk Decl. ¶ 19; Lavenue Decl. ¶ 5. The attorney who was assigned to and prepared the '187 application took up the application on February 6, 2004. See Lavenue Decl. ¶ 7. Prior

to taking up the '187 application, he worked only on unrelated matters that were received into the firm before the matter that became the '187 application. See *id.* Accordingly, he took up this matter in chronological order, and in the order he received it. See *id.* The Polk declaration, Vesper declaration, and the Lavenue declaration establish that, with the exception of those dates of excused diligence when the inventor was on vacation or attending to other duties, the inventor and attorney diligently took affirmative action toward constructively reducing his invention to practice by first preparing and then filing a U.S. patent application on September 30, 1997. See Polk Decl. ¶¶ 15-48; Vesper Decl. ¶¶ 3-9; and Lavenue Decl. ¶¶ 5-15.

3. Conclusion

Having established conception prior to the filing date of the Remington patent, and also have established reasonable diligence from a date just prior to the filing date of the Remington patent through the date of constructive reduction to practice of the present invention, the declarations and accompanying exhibits establish that the Remington patent is not a prior art reference. Applicant respectfully requests that the Examiner withdraw all rejections of claims based in whole or in part on the Remington patent, and reconsider all of the claims pending in the present invention.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 2, 2004

By:   
Lionel M. Lavenue  
Reg. No. 46,859

Attachments: Declaration of John Polk under 37 C.F.R. § 1.131 with Exhibits 1-62  
Declaration of Richard Vesper under 37 C.F.R. § 1.131  
Declaration of Lionel M. Lavenue Under 37 C.F.R. § 1.131